

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Applicant: Stewart et al.

Examiner: Garcia, Gabriel I.

Title: System, method and recordable medium for  
printing services over a network

Docket No.: MIME-0001-DIV

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF OF APPELLANTS**

Sir:

This paper is being filed in response to the Examiner's Answer dated 27 May 2010 to address clarifications to the Examiner's position newly presented in the Examiner's Answer.

## REMARKS

### I. Response to argument regarding rejection of claims 24-47 under 35 USC § 112, first paragraph

In the Examiner's Answer, the Examiner states that the "Examiner has read applicant's specification and conducted a search of the US publication 2004/005705 (equivalent to this application) using the terms 'automatical\$4 adj3 transmit\$4' or 'initiat\$4 adj4 interaction') were not found or described in the specification or drawings." Examiner's Answer, p. 9.

However, Appellants note that "[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." MPEP, 2163.02. To this extent, the results of the Examiner's search are not dispositive to a determination of whether the disclosure satisfies the description requirement. Rather, the Examiner must determine whether "the description clearly allow persons of ordinary skill in the art to recognize that... [Appellants] invented what is claimed." *Id.*, quoting *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

In the present case, Appellants have noted that support can be found, *inter alia*, in the disclosure at p. 18 and Fig. 7, 605, 610; and pp. 20-21 and Fig. 9, 506, 532. Using the disclosure, a person of ordinary skill in the art can create a system that implements the flow diagrams shown in Figs. 7 and 9. In operation, an embodiment of such a system would inherently automatically transmit the print file over a network for processing by a server in response to generating the print file without user-initiated interaction with the server. In particular, the disclosure and the corresponding flow diagrams do not show or

describe any user-initiated interaction with the server between generating the print file and transmitting the print file to the server. Furthermore, the disclosure and the corresponding flow diagrams do not discuss any user actions being performed or required in order to transmit the print file to the server after it is generated. As a result, Appellants respectfully submit that the subject matter of claims 24-47 is clearly supported by the disclosure.

In light of the above, Appellants respectfully request reversal of the rejection to claims 24-47 as allegedly not being enabled by the specification.

**II. Response to argument regarding rejection of claims 24-28, 30-39, and 41-47 under 35 USC § 103(a)**

In the Examiner's answer, the Examiner states that

Adamske et al teaches automatically allowing the user to uploading or transmitting and receiving the print file to the server without user initiated interaction with the server (reads on col. 5, lines line 64-thru col. 7, line 15, which clearly suggests that once the file is received the configuration wizard can send it to the server, and no user interaction is needed, the process is done automatically).

Examiner's Answer, p. 9. Initially, Appellants note that Adamske does not include any discussion of a configuration wizard, or any other type of wizard. As a result, it is unclear to which item in Adamske the Examiner is referencing. Furthermore, Appellants note that "automatically allowing the user to upload[] or transmit[]... the print file to the server" is clearly distinct from "automatically transmitting the print file" as in claim 24. In the former case, the user is "automatically" allowed to perform the action, while in claim 24, the action is performed automatically.

Regardless, as previously discussed, the cited portion of Adamske fails to teach or suggest generating a print file on a client, which is the same client on which image data is

later received, and displayed at an interface of the client as in claim 24. To the contrary, both embodiments described by Adamske expressly state that a printable electronic document is generated on an application translation server, which is distinct from the client at which the print preview is displayed. See, e.g., Adamske, col. 5, lines 15-28; col. 6, lines 49-54.

The Examiner also states that Adamske, Figs. 1, 2, 3 and col. 7, lines 16-44 provide support for "automatically transmitting a print file for processing by a server over a network in response to generating the print file without user-initiated interaction with the server." Examiner's Answer, pp. 9-10. However, Appellants note that Figs. 1 and 2 of Adamske provide no support for such a transmission being performed without user-initiated interaction with the server, let alone such a transmission being performed as part of a method of previewing a document as in claim 24. Additionally, Fig. 3 shows a web page displayed in a browser, which Adamske describes as being displayed after the user accesses the website, which constitutes user-initiated interaction with the server. Adamske, col. 4, line 61-col. 5, line 8. The discussion of col. 7, lines 16-44 of Adamske also is unrelated to previewing a document.

The Examiner also challenges Appellants' assertion that Adamske does not teach a user uploading a print file, but rather such a file is created on a server. Examiner's Answer, p. 10. The Examiner cites col. 3, lines 53-57 of Adamske as allegedly teaching the user uploading a print file to a server. *Id.* However, this portion of Adamske merely discusses the user uploading "an electronic version of a document." Adamske, col. 3, line 54. As described in both embodiments of Adamske, such a document is later converted to a print file on a translation server. See, e.g., Adamske, col. 5, lines 15-28;

col. 6, lines 49-54. In fact, the Examiner goes on to acknowledge that the electronic document "received by the server is processed (or converted) automatically to a file that can be received by a destination (printer)." Examiner's Answer, p. 10. Such a statement supports Appellants' contention that Adamske does not teach the user uploading a print file from a client to a server. Rather, as acknowledged by the Examiner, the electronic document uploaded in Adamske clearly requires some conversion prior to being sent to a printer.

In light of the above-stated reasons, Appellants respectfully request reversal of the rejections of claim 24 and claims 25-28, 30-31, and 44-47, which depend therefrom, as allegedly being unpatentable over the proposed combination of Adamske and Tonkin.

With respect to item 11, the Examiner indicates that the "Appeal brief does not identify any related proceeding(s)." Examiner's Answer, p. 11. However, Appellants note that the Appeal Brief does identify a related proceeding.

In summary, Appellants submit that independent claims 24, 32, and 36 are allowable over the cited art because the Examiner's use of Adamske, Tonkin, and/or Grohs fails to present a *prima facie* showing that each element of the claimed inventions is taught or suggested by the cited art. Additionally, Appellants respectfully submit that all other pending claims are allowable over the cited art by, *inter alia*, dependency.

Respectfully submitted,

/John LaBatt/

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